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Yoshikazu Kato

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EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

3621

NOTIFICATION DATE

DELIVERY MODE

08/04/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/656,274	Applicant(s) KATO, YOSHIKAZU	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the ‘Amendments to the Claims’ and ‘Remarks/Arguments’ filed on 19 May 2009 (“09 May Amendments” and “09 May Remarks,” respectively).
2. Claims 1-5 and 7-9 are currently pending and have been examined.
3. This Office Action is given Paper No. 20090723. This Paper No. is for reference purposes only.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181 and its discussion of C.F.R. §1.75. Correction of the following is required:
 - a. The “means for receiving” of claim 1;
 - b. The “means for storing” of claim 1;
 - c. The “means for managing” of claim 1;
 - d. The “means for reading” of claim 1;
 - e. The “means for arranging” of claim 1; and
 - f. The “means for composing” of claim 1.

Claim Rejections - 35 USC §101

5. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-3 and 7-9 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 1 and 7

7. These claims recite computer programs *per se*. “Computer programs claimed as computer listings *per se*, *i.e.*, the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being performed.” MPEP §2106.01 I. Because the claims recite only abstractions that are neither “things” nor “acts,” the claims are not within one of the four statutory classes of invention¹. Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

8. Additionally, Applicant’s original specification expressly states “[t]he series of steps described above may be executed by suitably functioning hardware or by software.” Specification, p. 31, last line – p. 32, first line. Because the claimed “means” and “unit[s]” may be interpreted as software *per se*, the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

¹35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures, and composition of

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9. Alternatively, the Examiner notes that using the broadest reasonable interpretation of “unit,” as noted below, the claimed “unit[s]” are interpreted as software only. Because the broadest reasonable interpretation of “unit” includes software *per se*, the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

Claim Rejections - 35 USC §112, 2nd Paragraph

10. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-3 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Regarding Claims 1-3

12. The following claim elements are means-plus function limitations that invoke 35 U.S.C. §112, sixth paragraph:

The “ordering means for receiving at least one order corresponding to a genre” of claim 1;

The “managing means for managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre” of claim 1;

matter. The latter three categories define “things” (or products) while the first category defines “actions” (*i.e.*, inventions that consist of a series of steps or acts to be performed).

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The “reading means for reading said plurality of content data from said storing means in response to an instruction” of claim 1;

The “arranging means for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means” of claim 1;
and

The “composing means for composing said plurality of content data arranged by said arranging means, into a single document including the plurality of content data for display” of claim 1.

13. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The Examiner has carefully searched the original specification and cannot determine the structure performing the recited functions.

14. Applicant is required to:

Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. §112, sixth paragraph; or

Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter. See 35 U.S.C. §132(a).

15. If Applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, Applicant is required to clarify the record by amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for

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performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter. See 35 U.S.C. §132(a).

16. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1, 3-5, 7, and 9, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Kent (U.S. 2002/0040374 A1) ("Kent"), in view of Nii (U.S. 2002/0065730 A1) ("Nii").

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Regarding Claims 1, 4, 5, and 7

19. Kent discloses the limitations:

ordering means (server **13**) for receiving at least one order corresponding to a genre (¶¶ 0035 and 0048);

storing means (content database **160**) for storing a plurality of content data corresponding to the at least one order (¶ 0079);

managing means (software program **100**) for managing preference data by which to determine preferences based on previous orders (¶¶ 0062 and 0065-0068);

reading means (optimization program **48**) for reading said plurality of content data from said storing means in response to an instruction (¶ 0079);

arranging means (profiling program **132**) for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means (¶ 0079); and

composing means (“printer”) for composing said plurality of content data arranged by said arranging means, into a single document including the plurality of content data for display (¶ 0083).

20. Kent discloses orders corresponding to a genre (¶¶ 0048 and 0054).

21. Kent does not directly disclose a means “by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre,” as recited in the claims.

22. Nii, however, discloses a method of and a system for distributing electronic content. In Nii’s method, Nii teaches “a tailoring parameters register” by which to determine preferences (“tailorization parameters”) based on a quantity of previous orders (“list of previous items purchased”), each order corresponding to a genre (¶¶ 0024, 0027, 0072, 0075, and 0079).

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23. In Nii the preferences are used for “tailorization of the content to be delivered on a terminal per terminal basis,” where “information to be delivered to that particular terminal is tailored in accordance with the preferences, settings, etc.”

24. This ability of Nii demonstrates the ability of one of ordinary skill in the art to apply these teachings to similar systems, such as the system of Kent.

25. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include the functionality of Nii’s system (*i.e.*, determining preferences based on a quantity of previous orders, each order corresponding to a genre) in the managing means of Kent (*i.e.*, software program **100**) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claims 3 and 9

26. The combination of Kent and Nii discloses the limitations of claim 1, as shown above, and further discloses the limitations:

wherein said plurality of content data include at least information for distinguishing said plurality of content data from other content data and information for indicating where said plurality of content data are stored in said storing means (Kent, ¶¶ 0079 and 0099-0100).

27. Claims 2 and 8, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Kent and Nii, in further view of Applicant’s Own Admission (“AOA”) (see “Response to Arguments,” below).

Regarding Claims 2 and 8

28. The combination of Kent and Nii discloses the limitations of claim 1, as shown above, and further discloses the limitations:

wherein said managing means determines said genre of said content data read by said reading means (§§ 0065-0068: program **100** chooses relevant articles based on criteria, here the type of article must be determined; see also § 0061: program **48** ensures content matches user's interests; § 0078: prioritizing content based on user interests; and §§ 0077 and 0079: program **48** and program **132** choose content that best relates to user profile).

29. Kent/Nii does not directly disclose the managing means associates the number of times that the plurality of content data belonging to said genre have been read with information for identifying a user for management purposes.

30. However, Applicant admits that metering content usage on a per use basis and associating the use with an identifier of a user is old and well-known in the art because this method reduces the cost to a user who may only want to use the content once. (Jake: Where's your source or authority for his admission?)

31. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the managing means of Kent and Nii with the old and well-known metering method. One would have been motivated to do so because this would provide a convenience to the user and lower costs to access content.

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Claim Interpretation

32. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- g. ***corresponding*** “adj. 1. Having the same or nearly the same relationship.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000.

Response to Arguments

Specification

33. Applicant argues:

With respect to the objection to the specification as failing to provide proper antecedent basis for the claimed subject matter, Applicants respectfully traverse this objection. Specifically, MPEP §1302.01 provides that

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually, the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See MPEP § 608.01(o). **It should be noted, however, that exact terms need not be used in haec verba** to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires substantial correspondence between the language of the claims and the language of the specification.

Moreover, 37 C.F.R. § 1.75(d)(1) states

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

See pp. 6-7, 09 May Remarks (emphasis in original).

34. The Examiner agrees with MPEP §1302.01. Nevertheless, the Examiner respectfully points out that the bold and underlined text from above (which Applicant emphasizes and thus appears to be basing his argument on) is followed by the text “to satisfy *the written description requirement of the first paragraph of 35 U.S.C. 112*” (emphasis added). Therefore, MPEP §1302.01 *does not* apply to the objection to the specification. Because MPEP §1302.01 *does not* apply to the objection to the specification, Applicant’s argument based on this section is not persuasive.

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35. Additionally, Applicant argues:

In the present case the terms “receiving, storing, managing, reading, arranging and composing” *would be clearly ascertainable to one skilled in the art*. These generally known terms would not cause confusion for one skilled in the art as the plain meaning of the terms is easily ascertainable. The purpose of the requirement in 37 C.F.R. § 1.75(d)(1) is to ensure that the terms recited in the claims are ascertainable and not confusing.

See p. 7, 09 May Remarks (emphasis added).

36. This argument is not persuasive. The Examiner notes that whether “the terms receiving, storing, managing, reading, arranging and composing would be clearly ascertainable to one skilled in the art” is a separate issue from the specification’s failure to provide proper antecedent basis for the claimed subject matter. 37 C.F.R. § 1.75(d)(1) does not mandate that the terms and phrases used in the claims “be clearly ascertainable to one skilled in the art” (as suggested by Applicant), the rule mandates that “the terms and phrases used in the claims must find clear support or antecedent basis in the description so that *the meaning of the terms in the claims may be ascertainable* by reference to the *description*.” See 37 C.F.R. § 1.75(d)(1) (emphasis added).

37. Additionally, Applicant argues “Moreover, Applicants wish to point out that the language ‘means for receiving’, ‘means for storing’, etc. appears in the originally filed claims. As such, this language is, by virtue of its existence in the original claims, already part of the originally filed specification.” See p. 7, 09 May Remarks.

38. While this may be true, the Examiner notes that the 37 C.F.R. § 1.75(d)(1) requires “the terms and phrases used in the claims must find clear support or antecedent basis in *the description* so that the meaning of the terms in the claims may be ascertainable by reference to *the description*” (emphasis added). The originally filed claims are not a part of the “description”

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of the originally filed specification. Since the objection to the specification is based on a deficiency in the *description*, Applicants' argument is not persuasive.

39. Additionally, the Examiner notes that the USPTO's Board of Patent Appeal and Interferences ("Board") has recently recognized the lack of antecedent basis of claim terms in the original specification as a "significant problem." See 73 Fed. Reg. 32944 (June 10, 2008) (noting that "[o]ne significant problem faced by the Board under Rule 41.37(c)(1)(v) occurs when the language of a claim does not have direct antecedent language in the specification.").

40. Additionally, the Examiner notes that patent examiners have no authority to waive the provisions of a rule. See *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987) (noting examiners have no authority to waive 37 C.F.R. §1.111(b)).

41. Because the lack of antecedent basis is currently recognized by the USPTO as a significant problem and because the Examiner has no authority to waive the provisions of a rule, correction of the noted objections to the specification under 37 C.F.R. § 1.75(d)(1) is required.

35 U.S.C. §101

42. With respect to claim 1, Applicant argues:

A person of ordinary skill in the art would recognize, based on the present specification, that an example of the "means" described in the specification includes the central processing unit 11 of device 2 shown in Applicants' Fig. 2, and the algorithm executed by the processor. Thus, the claimed "means" is not software per se, but includes the central processing unit and the algorithm.

See p. 8, 09 May Remarks.

43. The Examiner respectfully disagrees. The Examiner has carefully searched the original specification and cannot determine the corresponding structure performing the recited functions. Nevertheless, even if an *example* of the "means" described in the specification includes the

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central processing unit 11 of device 2 shown in Applicants' Fig. 2, other examples of the "means" are described in the original disclosure. For example, see parts 101-105 of figure 4 and "a storing element" on p. 3 of the specification. On pp. 11-12 of the spec Applicant states "The RAM 53 in the control center 3 retains *a program* with functions such as those shown in Fig. 4" (emphasis added). Therefore, parts 101-105 could be interpreted as parts of a program. Additionally, in light of Applicant expressly stating, "[t]he series of steps described above may be executed by suitably functioning hardware or by software" (spec, p. 31, last line – p. 32, first line), the "storing element" could be interpreted in the spec as a software element.

44. Moreover, the Examiner cannot locate in the original specification the "algorithm executed by a processor," to which the Applicant is referring.

45. With respect to claim 7, this claim has been amended to recite "a management unit implemented *using a central processing unit* and configured to manage a preference data..." (emphasis added). The Examiner notes that while a "central processing unit" may be interpreted as hardware, the central processing unit is not positively recited in the claim. Accordingly, the claim is interpreted as software *per se*. If the '*using a central processing unit*' was considered positively recited and because of the term "using," the claim would be indefinite under 35 U.S.C. § 112 2nd paragraph because the claim would be a hybrid claim. See MPEP §2173.05(p) II.

35 U.S.C. §112, Second Paragraph

46. With respect to claims 1-3, Applicant argues:

With regard to the rejection of Claims 1-3 under 35 U.S.C. §112, second paragraph, Applicants respectfully traverse this rejection.

The outstanding Action states in item "p." on page 7 that "the written description fails to disclose the corresponding structure, material, or acts for the

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claimed function.” Applicants respectfully traverse this assertion as clearly erroneous.

See p. 8, 09 May Remarks.

47. The Examiner respectfully disagrees. The rejection is clearly not erroneous. For example, the Examiner has carefully searched the original specification for structure corresponding to:

The “ordering means for receiving at least one order corresponding to a genre” of claim 1;

The “managing means for managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre” of claim 1;

The “reading means for reading said plurality of content data from said storing means in response to an instruction” of claim 1;

The “arranging means for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means” of claim 1; and

The “composing means for composing said plurality of content data arranged by said arranging means, into a single document including the plurality of content data for display” of claim 1.

48. The Examiner cannot determine the corresponding structure for performing the recited functions because the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

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Prior Art

49. Applicant argues:

However, Kent does not describe or suggest managing, using the information processing apparatus, preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre and arranging, using the information processing apparatus, said plurality of content data read in said reading, in accordance with said preference data managed in said managing.

See p. 9, 09 May Remarks (emphasis in original).

50. The Examiner respectfully disagrees. Kent's "software program **100**" performs the function of managing preference data by which to determine preferences based on previous orders, and Kent's "profiling program **132**" performs the function of arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means. Kent may not explicitly determine preferences based on the exact preference data as in the claims; however, the Examiner relies on Nii for such determining of preference data. Accordingly, Applicant is arguing the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

51. Additionally, Applicant argues:

However, Nii does not describe or suggest managing, using the information processing apparatus, preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre and arranging, using the information processing apparatus, said plurality of content data read in said reading, in accordance with said preference data managed in said managing.

See p. 10, 09 May Remarks (emphasis in original).

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52. The Examiner respectfully disagrees. Applicant again is arguing the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

53. Additionally, Applicant argues "For example, nothing in Nii describes that each order corresponds to a genre." See p. 10, 09 May Remarks (emphasis in original). The Examiner respectfully disagrees.

54. In the previous Office action mailed on 18 March 2009 (Paper No. 20090305) the Examiner interpreted *genre* to mean "A type or class." See ¶ 27 ee. For example, a movie is a "type" of content, hence movies are a genre of content. Nii describes the various content genres of his invention in ¶ 0027 (e.g., movies, music, games, electronic magazines, periodicals, newspaper, and tv news). Furthermore, in ¶ 0079 Nii teaches that the preferences can be based on a "list of previous items purchased by this potential customer" (i.e., the preferences are based on a quantity of previous orders). For example, the list could be of a movie purchased at a movie store and a game purchased at a gaming store. Therefore, each order in the list corresponds to a genre or type of content.

55. Additionally Applicant argues "Further, nothing in Nii describes arranging said plurality of content data in accordance with preference data which is based on a quantity of previous orders." See p. 10, 09 May Remarks (emphasis in original). This argument is not persuasive because the Examiner does not rely on Nii for the entire limitation "arranging said plurality of

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content data in accordance with preference data which is based on a quantity of previous orders.”

Again, Applicant is arguing the references individually.

Official Notice

56. Applicants’ attempt at traversing the Official Notice findings as stated in the previous Office Action (Paper No. 20090305, ¶ 23 bb) is inadequate. Adequate traversal is a two step process. First, Applicant must state their traversal on the record. Second and in accordance with 37 C.F.R. §1.111(b) which requires Applicant to specifically point out the supposed errors in the Office Action, Applicant must state *why* the Official Notice statements are not to be considered common knowledge or well known in the art.

57. In this application, Applicant has not met step (1) or step (2) because Applicant has failed to clearly state a traversal to the Official Notice statements and has failed to argue *why* the Official Notice statements are not to be considered common knowledge or well known in the art. Because Applicant’s traversal is inadequate, the Official Notice statements from Paper No. 20090305, ¶ 23 bb are taken to be admitted prior art. See MPEP §2144.03.

Conclusion

58. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

59. Because this application is now final, Applicant is reminded of the USPTO’s after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed.

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Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112, 1st paragraph written description and enablement, §112, 2nd paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

60. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

61. The prior art made of record and not relied upon is considered pertinent to Applicant’s disclosure (see attached form PTO-892).

62. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on

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Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

63. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
July 23, 2009

/ANDREW J. FISCHER/
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